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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 0504

Application Number: 09/710,342
Filing Date: November 09, 2000
Appellant(s): SWAINE ET AL.

Mr. Gregory A. Welte
For Appellant

EXAMINER'S ANSWER

MAILED
JUN 25 2004
GROUP 2800

This is in response to the appeal brief filed 12 March 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 7-10, 21, 22, 24-26, 28, 32, 33, 36, 38, 40, and 41 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,705,798	Tarbox	1-1998
2,304,449	Wheeler	3-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10, 21, 22, and 24-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbox (US 5,705,798) in view of Wheeler (GB 2,304,449), cited by the applicant.

Re claims 1-10, 24, 31, 33-35, 40, and 41: Tarbox teaches an ATM machine 101 comprising a user interface including a group of indicators for entering data, each indicator being associated with a pre-defined transaction so that a user may execute a desired transaction by selecting a single indicator; wherein each indicator includes a push button and protrudes from a surface on which the indicator is mounted; and wherein the pre-defined transaction is programmed by a user and/or the owner of the terminal. The user interface also includes an identifier 109, a dispensing area 111, and a touch sensitive display. (See col. 1, lines 12-29; col. 6, line 11 to col. 7, line 61)

Re claims 21, 22, 28, 29, 32, 36-38, 37, and 41: The ATM machine further comprises a controller means for accepting instructions for allowing *i*) a first user to program a first button to perform a first predetermined function, when later actuated by the first user and *ii*) a second user to program the first button to perform a second predetermined function, different from the first predetermined function, when later actuated by the second user. (See col. 6, line 11 to col. 7, line 61)

Re claim 26, wherein the touch sensitive display is effective to enable a sighted person to select and execute a transaction, with reference to text presented on the display.

Tarbox fails to teach or fairly suggest having indicators/buttons of different shapes such as a diamond shape, a circular shape, etc., or colors, wherein the indicators/buttons are effective to enable a blind person to select and execute a transactions and are distinguishable from each other by a blind person, based on shape.

Wheeler teaches a telephone apparatus having push buttons with unique attribute relating to the size, shape, and color of the push buttons and wherein the buttons are effective to enable a blind person to select and execute a transaction and wherein the buttons are distinguishable from each other by a blind person, based on shape (see figures 3, 4, and 12; col. 1, lines 6-17; col. 3, lines 21-30; and col. 18, lines 17-25). In view of Wheeler's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known push button keypad having differently shaped and color push buttons wherein the buttons are distinguishable from each other by a blind person and are effective to enables a blind person to select and execute a transaction to the teachings of Tarbox to allow a visually impaired person to easily identify the push buttons when conducting a transaction thus, reducing operation/transaction error made by the visually impaired person. Furthermore, it would have been obvious to have such indicators in order to make the user interface of the ATM machine aesthetically pleasing to the user.

(11) Response to Argument

The examiner respectfully disagrees with appellant's comments and arguments as stated in the "ARGUMENT" section of the Appeal Brief, for the following reasons:

With respect to appellant's piecemeal analysis of the references, that is Tarbox and Wheeler (see pg. 10 through pg. 20 of the appeal brief filed on 3/12/04), the examiner believes that one cannot show non-obviousness by attacking references individually where, as here, the above rejections are based on combinations of references. Further, the examiner respectfully submits to the appellant that, "It is not necessary that the references actually suggest, expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present in the prior art." *In re Scheckler*, 58 CCPA 936, 438 F. 2d 999, 168 USPQ 716 (1971). In this case, Tarbox teaches an ATM machine including a user interface having a group of buttons for entering data, each button being associated with a pre-defined transaction so that a user may execute a desired transaction by selecting a single button. Wheeler teaches a telephone apparatus having push buttons that are different in size, shape, and/or color. Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the

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combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). The Tarbox reference teaches an ATM machine having a plurality of buttons. The Wheeler reference shows a telephone apparatus having a plurality of buttons that are different in size, shape, and/or color.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use buttons having different sizes, shapes, and/or colors as taught by Wheeler to the teachings of Tarbox in order to enable a visually impaired person to easily identify the buttons when conducting a transaction, thus reducing operation/transaction error made by the visually impaired person. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

In response to appellant's argument that "the references lie in non-analogous arts" (see page 12 of the appeal brief filed on 3/12/04), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, The Tarbox reference teaches an ATM machine having a plurality of buttons. However, Tarbox fails to show an ATM machine having a plurality buttons of different shape, size, and/or color. The Wheeler reference shows a telephone apparatus having a plurality of buttons that are different in size, shape, and/or color. The examiner believes that the combination of these references meets the limitations set forth in the claims.

In response to appellant's argument that the claim language prohibits two buttons of the same shape and that Wheeler shows three shapes but 14 buttons (see page 12 of the appeal brief filed on 3/12/04). The claims recite that each indicator being different in size, shape, color, or texture, or a combination thereof. Wheeler teaches an apparatus having push buttons being different in size, shape, and/or color. Thus, Wheeler meets the limitation that each button/indicator are different as describe above.

In response to appellant's argument that substituting Wheeler's keypad for that of Tarbox does not show the claimed invention (see pages 13-16 of the appeal brief filed on 3/12/04). The Wheeler reference is not used to replace the keypad as shown in figure 12 for that of Tarbox keypad 107. Tarbox teaches an ATM having programmed buttons 105 that initiate a transaction. Based on figure 1 of the Tarbox reference, the buttons 105 are square in shape. The Wheeler reference is used to show a plurality of buttons that are different in size, shape, and/or color. Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use buttons having different sizes, shapes, and/or colors as taught by Wheeler to the teachings of Tarbox in order to enable a visually impaired person to easily identify the buttons when conducting a transaction, thus reducing operation/transaction error made by the visually impaired person.

In response to appellant's argument, regarding claim 7, that the predefined transaction is programmed by the owner of the terminal (see page 30 of the appeal brief filed on 3/12/04), it is well known in the art for ATM machines and other transaction

machines to have predefined transaction that are programmed by the owner of the machine/terminal.

Appellant's argument with respect to claims 8-10, 21, 24(b), 25, 32, 33, and 38 (see pages 30-34 of the appeal brief filed on 3/12/04) have been addressed above.

In response to appellant's argument with respect to claims 24(a) and 26 (see pages 32 and 33 of the appeal brief filed on 3/12/04), Tarbox discloses an ATM machine having a touch-sensitive display (see col. 1, lines 24-27).

In response to appellant's argument, regarding claim 6, that the predefined transaction is programmed by a user (see page 35 of the appeal brief filed on 3/12/04), Tarbox teaches a system for allowing a user to personalize the terminal displays and selection options based on his or her own preferences (see col. 2, line 55+).

Appellant's argument with respect to claims 21(b), 22, 28, 36, 40, and 41 (see pages 36-39 of the appeal brief filed on 3/12/04) have been addressed above.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,




AAT

June 7, 2004

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